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REMARKS

Claims 1 - 54 are pending in the present Application. Claims 12, 41 and 54 have been amended, leaving Claims 1 - 54 for consideration upon entry of the present Amendment. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

Amended Claims

Claims 12, 41 and 54 have been amended to include values of X and Y to better define the invention and not to overcome any prior art.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1 - 54 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office Action dated February 9, 2004, page 2)

In particular, the Examiner has stated that "[i]n Claims 1 and 25, the values of variables X and Y defined as -cyclic aliphatic heterocycle and cyclic aromatic heterocycle ---- are indefinite since the size of the ring number and types of heteroatoms present in the ring are not defined". (Office Action dated February 9, 2004, page 2)

The Applicants respectfully disagree. In the first instance, the Applicant submits that the values of variables X and Y, in particular the terms cyclic aliphatic heterocycle and cyclic aromatic heterocycle would be ascertainable to one of skill in the art. The MPEP in section 2173.02 states that "[i]n reviewing a claim for compliance with 35 U.S.C. § 112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim appraises one of ordinary skill in the art of it's scope and, therefore, serves the notice function required by 35 U.S.C. § 112, second paragraph <by providing clear warning to others as to what constitutes infringement of the patent>. See, e.g., *Solomon v. Kimberley Corp.*, 216 F. 3d 1372, 1379 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). One of ordinary skill in the art could easily ascertain the structures of a cyclic aliphatic heterocycle and a cyclic aromatic heterocycle without much difficulty since such structures are commonly known. The fact that

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these structures are commonly known is also evident from the fact that the same Examiner has allowed similar patents to issue without such a rejection.

For example, U.S. Patent No. 6,620,939 to the same Applicants (which was the parent application of this divisional and which was responded to by the same Patent Agent) was allowed to pass to issue by the same Examiner without a similar rejection under 35 U.S.C. § 112, second paragraph. The claims of U.S. 6,620,939 were allowed to issue despite having limitations similar to the claims of the present application. The Applicants respectfully request that in view of the fact that one of ordinary skill in the art can easily ascertain the structures of a cyclic aliphatic heterocycle and a cyclic aromatic heterocycle, the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph and permit this application to issue.

In Claims 11 and 40, last line, the term ---functionalized benzimidazole mercaptan--- is indefinite since the meaning is not clear. (Office Action dated February 9, 2004, page 2)

Applicants respectfully disagree. The functionalized benzimidazole mercaptan are clearly defined in the specification in paragraphs [0013.5], [0013.6] and [0013.7] which were submitted in the preliminary amendment dated July 25, 2003. In referring to the specification, one of ordinary skill in the art would be appraised and educated as to the different structures of benzimidazole mercaptans that can be obtained and used.

Additionally, with regards to both Claim 11 and Claim 40, MPEP section 2164 states that "[t]he purpose of the requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention. A patent claim is invalid if it is not supported by an enabling disclosure". Clearly the benzimidazole mercaptans are clearly described in the specification and one of ordinary skill in the art could practice the invention by reading the

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specification. In view of this, the Applicants respectfully request a withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, and an allowance of the claims.

In addition, the courts have held that “[a]s long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir.), cert. denied, 484 U.S. 954 (1987).

It is further submitted to the Examiner, that the examples in the application disclose at least one method for making the claimed invention that bears a reasonable correlation to the entire scope of the claim as required by the courts. See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

Thus, in summary, the specification describes in great detail how to make the desired composition and one of ordinary skill in the art upon reading the specification would clearly understand how to make the claimed compositions. Since the specification also clearly shows at least four benzimidazoles in Table 1 that may be used to practice the claimed invention, the Applicant believes that the present specification is enabling and respectfully requests a withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

In Claims 12, 41 and 54, the values of X and Y are not defined. (Office Action dated February 9, 2004, page 2)

Claims 12, 41 and 54 are now amended to include the values of X and Y, and hence this rejection is moot.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 54 stands rejected under 35 U.S.C. § 102(b), as allegedly being anticipated by JP 02108039 to Hirano. (Office Action dated February 9, 2004, page 2) Applicants respectfully traverse this rejection.

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To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Variant Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). An examination of the Claim 54 reveals the presence of two linking functionalities X and Y, wherein X is a linking functionality wherein one member selected from the group consisting of a linear aliphatic chain comprising between about 1 and about 11 carbon atoms, a cyclic aliphatic ring comprising at least 5 carbon atoms, a cyclic aromatic ring comprising at least 6 carbon atoms, a cyclic aliphatic heterocycle comprising at least 3 carbon atoms, and a cyclic aromatic heterocycle comprising at least 3 carbon atoms; and wherein Y is a linking functionality wherein one member selected from the group consisting of a linear aliphatic chain comprising between about 1 and about 11 carbon atoms, a cyclic aliphatic ring comprising at least 5 carbon atoms, a cyclic aromatic ring comprising at least 6 carbon atoms, a cyclic aliphatic heterocycle comprising at least 3 carbon atoms, and a cyclic aromatic heterocycle comprising at least 3 carbon atoms. In contrast, the structure presented in Hirano does not contain the linking groups. For this reason at least the reference cannot anticipate Claim 54 and the Applicants respectfully request a withdrawal of the rejection under 35 U.S.C. § 102 (b).

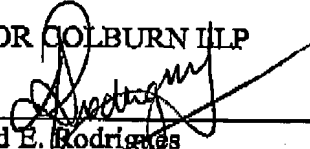
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It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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